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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,574

01/23/2004

Tejichiro Umezawa

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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/762,574	Applicant(s) UMEZAWA ET AL.	
	Examiner Kevin M. Bernatz	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
 4a) Of the above claim(s) 3,4 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6 and 11-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. Amendments to the claims filed on November 13, 2006 and December 18, 2006, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Request for Continued Examination

3. A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 8, 2007 has been entered. An action on the RCE follows.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 5, 6, 11, 12 and 16 – 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 12 of U.S. Patent No. 6,759,138 B2 (Tomiyasu et al.) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on May 12, 2006, which refers back to Paragraph No. 8 of the Office Action mailed on September 13, 2005.

The Examiner notes that the amended language has been addressed per the Examiner's comments in Paragraph 3 of the Office Action mailed on May 12, 2006.

Claim Rejections - 35 USC § 102

6. Claims 1, 2, 5, 6, 11, 12 and 16 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomiyasu et al. ('138 B2); - **and** -

Claims 1, 2, 5, 6, 11, 12 and 16 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomiyasu et al. (U.S. Patent App. No. 2003/0104248 A1); - **and** -

Claims 1, 2, 5, 6, 11, 12 and 16 – 19 are rejected under 35 U.S.C. 102(f) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on May 12,

2006, which refers back to Paragraph No. 10 of the Office Action mailed on September 13, 2005.

Claim Rejections - 35 USC § 103

7. Claims 1, 2, 5, 6, 11 – 13 and 16 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abarra et al. (U.S. Patent No. 6,602,612 B2) in view of Fukuzawa et al. (U.S. Patent App. No. 2005/0030676 A1); – ***and*** –

8. Claims 1, 2, 5, 6, 11 – 13 and 16 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abarra et al. (U.S. Patent App. No. 2001/0055701 A1) in view of Fukuzawa et al. ('676 A1). See U.S. Patent '612 B2, which is the U.S. Patent based on the Abarra et al. U.S. Published Patent Application '701 A1.

These rejections are maintained for the reasons of record as set forth in Paragraph No.'s 7 and 8 of the Office Action mailed on May 12, 2006.

9. Claims 14, 15, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abarra et al. (either reference) in view of Fukuzawa et al. as applied above, and further in view of Chen et al. (U.S. Patent No.5,846,648) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on May 12, 2006

Response to Arguments

10. The Double Patenting rejection of claims 1, 2, 5, 6, 11, 12 and 16 - 19 in view of Tomiyasu et al. ('138)

Applicants have not presented any distinct arguments directed to this rejection in the submissions of November 13, 2006 and December 18, 2006.

11. The rejection of claims 1, 2, 5, 6, 11, 12 and 16 - 19 under 35 U.S.C § 102(e) and/or 102(f) – Tomiyasu et al., various references

Applicants have not presented any distinct arguments directed to this rejection other than those presented in the submissions of November 13, 2006 and December 18, 2006. The Examiner notes that these arguments were addressed in the Advisory Action mailed on December 21, 2006.

12. The rejection of claims 1, 2, 5, 6, 11 – 13 and 16 - 20 under 35 U.S.C § 103(a) – Abarra et al., both references, in view of various references

Applicants have not presented any distinct arguments directed to this rejection other than those presented in the submissions of November 13, 2006 and December 18, 2006. The Examiner notes that these arguments were addressed in the Advisory Action mailed on December 21, 2006.

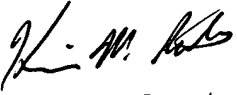
Conclusion

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
March 27, 2007


Kevin M. Bernatz, PhL
Primary Examiner